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IN THE

Supreme Court of the United States

OCTOBER TERM, 1947.

No. [redacted] 8

OSTBY AND BARTON COMPANY and
AMERICAN ASSOCIATES, INC.,
Petitioners,

v.

THOGER GRONBERG JUNGERSEN,
Respondent.

PETITION FOR WRIT OF CERTIORARI
To the United States Circuit Court of Appeals
For the Third Circuit, and
BRIEF IN SUPPORT OF PETITION

Alexander C. Neave
JOHN VAUGHAN GROSSE,
EDWARD WINSOR,
Counsel for Petitioners.

New York, N. Y.
December 3, 1947.

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TO THE HONORABLE THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

PETITION FOR WRIT OF CERTIORARI

To the United States Circuit Court of Appeals For the Third Circuit

The petition of Ostby and Barton Company and American Associates, Inc. prays the issue of a writ of certiorari to the Circuit Court of Appeals for the Third Circuit to review so much of a decision and order of that court en-

tered September 5, 1947, as holds valid Claims 1 to 4 of United States Letters Patent No. 2,118,468. A transcript of the record, including the proceedings in said Circuit Court of Appeals, has been filed herein pursuant to Rule 38.

Summary and Short Statement of Matters Involved

Action herein was instituted by Ostby and Barton Company for Declaratory Judgment that Jungersen patent No. 2,118,468 was invalid and not infringed (R., pp. 1a-9a). Respondent counterclaimed (R., pp. 9a-16a). Subsequently, having acquired all of the assets of Ostby and Barton Company and the latter having been dissolved, American Associates, Inc. was added as a party plaintiff (R., pp. 33a-39a). At a still later period, petitioner Ostby and Barton Company, a new corporation, having taken over the business formerly conducted by the old Ostby and Barton Company, was added as a party plaintiff (R., p. 376). Following hearing, the District Court filed its opinion (R., pp. 22a-32a; 65 F. Supp. 652) and its findings of fact and conclusions of law (R., pp. 32a-39a) holding Claims 1 to 4 of said patent valid but not infringed and Claims 5 and 6 of said patent invalid. Both parties appealed (R., pp. 44a, 45a), petitioner with respect only to the holding that Claims 1 to 4 were valid, and respondent with respect to the holding that Claims 5 and 6 were invalid. The Circuit Court of Appeals, in a *per curiam* decision, affirmed the court below "for the reasons stated" in the opinion of the District Court (R., p. 378; 163 F. 2d 312).

During the pendency of this action in the District Court, respondent instituted action for infringement of the same patent in the District Court of the United States for the Southern District of New York against Baden & Foss, a

partnership. Thereafter seven corporations and fifteen individuals, comprising six partnerships, having been threatened by claims of infringement of the Jungersen patent, intervened in the *Baden* case and became defendants therein. This action, after hearing, was decided by the District Court (Judge Simon Rifkind) in April 1947, the court holding that all six claims of the patent in suit were invalid and void (69 F. Supp. 922). The respondent has filed an appeal to the Circuit Court of Appeals for the Second Circuit in that action and this appeal, in normal course, should be heard within the next sixty days.

Question Presented

Are Claims 1 to 4 of Jungersen patent No. 2,118,468 valid as held below or invalid as held in the *Baden* case?

Reasons Relied Upon for the Allowance of the Writ

1. The decisions herein are in direct conflict with the established rule of law as to equivalence most recently set forth by this Court in *Dow Co.* v. *Halliburton Co.*, 324 U. S. 320, 330.

2. It is recognized that the divergence of result reached by the District Court for the District of New Jersey and the Circuit Court of Appeals for the Third Circuit in this action, and that reached by the District Court for the Southern District of New York in the *Baden* case, do not constitute a conflict of the sort ordinarily recognized by this Court as affording reason for the allowance of petition for certiorari. The decision in the *Baden* case is now pending on appeal and an affirmance of the District Court's decision by the Circuit Court of Appeals for the Second Circuit, it is submitted, will afford the type of conflict which is recognized.

WHEREFORE, petitioners pray that this petition for writ of certiorari be granted, or that action thereon be withheld pending decision in the *Baden* case.

Respectfully submitted,

ALEXANDER C. NEAVE

JOHN VAUGHAN GRONER,
EDWARD WINSOR,
Counsel for Petitioners.

New York, N. Y.
December 3, 1947.

I hereby certify that in my opinion the foregoing petition for writ of certiorari is well founded in point of law and is not filed for delay.

ALEXANDER C. NEAVE

JOHN VAUGHAN GRONER,
Counsel for Petitioners.

BRIEF IN SUPPORT OF PETITION

Opinions of the Courts Below

The opinion of the District Court (R., pp. 22a-32a) is reported in 65 F. Supp. 652. The opinion of the Circuit Court of Appeals for the Third Circuit (R., p. 378) is reported in 163 F. 2d 312.

The opinion of the District Court for the Southern District of New York in *Jungersen* v. *Baden,* involving a record which generally is the equivalent of that here, is reported in 69 F. Supp. 922.

Jurisdiction

The grounds of jurisdiction are

1. The Opinion and Order of the Court of Appeals having been filed and entered on September 5, 1947, the time for filing this petition extends until December 5, 1947.

2. The statute under which jurisdiction is invoked is Section 240a of the Judicial Code, as amended (28 U. S. C. A. § 347).

3. Cases believed to sustain the jurisdiction are: *Sanitary Refrig'r Co.* v. *Winters,* 280 U. S. 30; *Dow Co.* v. *Halliburton Co.,* 324 U. S. 320, 330; *General Electric Co.* v. *Jewel Co.,* 326 U. S. 242.

Argument

1. The patent in suit relates to a method of casting. The sequential steps are (a) the making of a model, (b) the making of a (primary) mould around the model, (c)

the making of wax replicas or patterns in the mould, (d) the investment of the patterns—*i.e.*, the formation of a plaster-of-paris-like (secondary) mould around the patterns, (e) the burning out of the wax leaving a cavity in the secondary mould and (f) the casting of metal into this cavity (R., p. 502a).

These steps, in the sequence shown, are at least as old as Cellini (R., pp. 448a-469a, 499a). The only improvement even claimed by respondent (cf., R., p. 495a, lines 19-28) is found in the particular kind of primary mould used and in the particular means for casting the wax pattern. The patent discloses the use of a rubber mould and the casting of the wax by centrifugal force. Both rubber moulds (R., pp. 151a, 400a, 424a, 427a, 444a) and centrifugal force (R., pp. 417a, 484a-485a, 160a-161a) were old and well known.

Claims 1 to 4 are limited to all or some of the exact steps shown in the patent.

The decision of the District Court and of the Court of Appeals in holding Claims 1 to 4 valid is in direct conflict with the rule of *Dow Co.* v. *Halliburton Co.*, 324 U. S. 320, and also is in conflict with the law and the facts in the *Baden* case in the Southern District of New York.

Kralund patent No. 1,238,789 discloses each step of the Jungersen patent here in issue (R., pp. 413a-416a, 499a). Instead, however, of casting the wax patterns under the pressure of centrifugal force, as taught by Jungersen, Kralund does it under the pressure of a die casting machine (R., pp. 414a, lines 53-61, 70-85). Both a die casting machine and a centrifugal machine were well known means of applying pressure in the casting of molten material long prior to Jungersen (R., pp. 160a-161a, 150a, 413a, 417a, 477a), and that they are pure equivalents is not even contested by Jungersen.

The statement of this Court in *Dow Co.* v. *Halliburton Co.*, 324 U. S. 320, 330, is controlling:

> "It is elemental that the mere substitution of equivalents which do substantially the same thing in the same way, even though better results may be produced, is not such an invention as will sustain a patent."

Despite this—or in disregard of it—the District Court here, and the Circuit Court of Appeals in affirming "for the reasons stated" (R., p. 378; 163 F. 2d 312), held that

> "it is no argument for invalidity to assert that the use of centrifugal force is the mere substitution of equivalents which do substantially the same thing" (R., pp. 26a-27a; 65 F. Supp. 652, 656).

The decision below is in square conflict with the established rule.

Similarly, it cannot be reconciled with the court's ruling in the *Baden* case. There (69 F. Supp. 922), upon facts generally like those present here, Judge Rifkind held (pp. 926-927):

> "The need of force for casting the wax was taught by Kralund who used a die casting machine. Moreover, by his claim of infringement plaintiff (Jungersen) practically concedes the equivalence of the several modes for the application of force, namely, syringes, air pressure and centrifugal machines. * * *
>
> "Once the use of force for the introduction of the wax into the mould was known to be desirable—and Kralund shows it—the choice of alternative means for the application of force became a noninventive application of the skill of the caster's art."

Clearly the courts below, in the instant case, have decided a federal question in a way definitely in conflict with applicable decisions of this Court and of the New York District Court.

The District Court—and thus the Court of Appeals—also fell into error in two other respects:

(a) It conceived the step, in the process of the patent, of casting the wax by the use of centrifugal force, to be a "new step" or an "additional step" in the practice of the process (R., p. 25a; 65 F. Supp. 655) and that the patent itself was directed to "a combination of old elements, to which a new element has been added" (R., p. 26a; 65 F. Supp. 655). In fact, it was simply an old process wherein at one step particular means were used to do identically what had been done before by other means. Illustratively, Cellini (R., p. 448a), Spencer (R., p. 400a), Haseltine (R., p. 427a), La Gravure (R., p. 469a), Kralund (R., p. 413a) and Austenal (R., pp. 299a-300a, 314a-316a), all practised every step disclosed in the Jungersen patent. Instead, however, of casting their wax patterns by centrifugal force, Cellini, Spencer, Haseltine and La Gravure cast the wax by gravity; Kralund by a pressure die casting machine and Austenal by the pressure of an eye dropper (R., p. 149a).

(b) It in effect disqualified the prior art references on the theory that they came from "nonanalogous casting arts" (R., p. 24a; 65 F. Supp. 655). Similarly, the court conceived that there was a distinct "jewelry art" to which the patent was directed (R., pp. 24a-25a; 65 F. Supp. 655). In these conceptions the court erred in two respects. First, there is no distinct "jewelry art." "Jewelry casting is just part of the casting art" (R., pp. 164a, 145a). And if jewelry casting were a separate art, the patent in suit is not limited to it. Its title is "Method of Casting

Articles of Intricate Design and a Product Thereof" (R., p. 502a). Its objects are "to facilitate the casting of small metal articles, particularly articles of intricate detail such as jewelry" (R., p. 502a, lines 1-4), and "to enable the formation of intricate castings" (R., p. 502a, lines 10-11; see also *Jungersen* v. *Baden*, 69 F. Supp. 922, 927-928).

2. An affirmance by the Circuit Court of Appeals of the District Court's decision in the *Baden* case will present the type of conflict which this Court recognizes as affording basis for the grant of a writ (Supreme Court Rule 38, paragraph 5(b); *Sanitary Refrig'r Co.* v. *Winters*, 280 U. S. 30; *Dow Co.* v. *Halliburton Co.*, 324 U. S. 320, 330; *General Electric Co.* v. *Jewel Co.*, 326 U. S. 242). Beyond this, however, in view of the lower court's refusal to apply a rule of law established by this Court (*Dow Co.* v. *Halliburton Co., supra*), it is submitted that reason now exists for the exercise by this Court of its power to grant this petition (*Gulf State Steel Co.* v. *United States*, 287 U. S. 32, and see "Jurisdiction of Supreme Court of United States"—Robertson & Kirkham, § 295, p. 578). However, should this Court be unwilling at this time to exercise that power, it is suggested that the facts here exactly parallel those in *American Surety Co.* v. *Baldwin*, 287 U. S. 156, 163 (see also, *United States* v. *Anderson*, 284 U. S. 584; *Burnet* v. *Howes Brothers Hide Co.*, 284 U. S. 583; *Handy & Harmon* v. *Burnet*, 284 U. S. 136). And in accord with the rule of the *American Surety* case, it is submitted this Court might withhold action on this petition until the Court of Appeals shall have decided the *Baden* case.

WHEREFORE, petitioners pray that this petition for writ of certiorari be granted, the cause reviewed and the judgment of the Circuit Court of Appeals for the Third Circuit

reversed as to Claims 1 to 4, or, in the alternative, that action on this petition be withheld pending decision by the Court of Appeals for the Second Circuit in the *Baden* case.

Respectfully submitted,

ALEXANDER C. NEAVE
JOHN VAUGHAN GRONER,
EDWARD WINSOR,
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New York, N. Y.
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